



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,008	11/15/2000	Johann Engelhardt	102847-28	1885

21710 7590 07/31/2002

BROWN, RUDNICK, BERLACK & ISRAELS, LLP.
BOX 1P, 18TH FLOOR
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER

FERNANDEZ, KALIMAH

ART UNIT PAPER NUMBER

2881

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/681,008

Applicant(s)

ENGELHARDT, JOHANN

Examiner

Kalimah Fernandez

Art Unit

2881

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 8-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 8-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: misspelling of rotatable in line 3. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2,4-6,and 8-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stein and in view of US Pat No 6,262,838 issued to Montagu.
4. Stein teaches a multiscanning confocal microscope having a turntable (32) rotatable (col.2, line 65-col.3, line 5).
5. Stein teaches a scanning head (42) for optically scanning the specimens to provide positional data and an optical scanning device (30) mounted upon arm (38) (col.3, lines 2-29).
6. Stein does not teach said optical scanning device (30) is rotatable.
7. However, Montagu teaches a scanning microscope having a rotatable scanner mounted upon a carrying arm (32)(col.7, lines 27-32).

8. It would have been obvious to an ordinary artisan to combine the teachings of Montagu and Stein since Montagu teaches improved auto-focusing for scanning microscope (col.3, lines 8-25).
9. As per claim 4, Montagu teaches the distance between the scanning device and the sample is held constant (col.8, lines 4-12).
10. As per claim 5, Stein teaches the regulation of the rotational speed of the specimen-receiving device and the rotation speed of the turntable dependent on each rotation of the arm (38) (col.3, lines 9-29).
11. As per claim 6, Stein teaches the rotation of the turntable being regulated by positional data (col.3, lines 30-42).
12. As per claim 8, Stein teaches the adaptability for one or more slides (4) (col.2, lines 65-67).
13. As per claims 9-10, Stein teaches a carousel-type sample holder. It is not considered non-obvious to adapt said holder to be replaceable, since such inserts are common and expected in the art.
14. As per claim 13, Stein discloses automatic focusing (col.5, lines 16-25).
15. As per claim 14, Stein discloses a deviation of 5 microns (col.5, lines 25-31).
16. As per claim 15, Stein discloses a laser source (2) and photo detector (12) (col.2, line 18; col.2, line 57).
17. As per claim 16, Stein teaches two-dimensional scanning.
18. As per claim 17, Stein teaches a stationary laser (2) (see fig. 1a).

19. As per claim 21, Montagu teaches tilting the sample to non-zero laser incidence angle (col.5, lines 15-25).
20. As per claim 22, Stein teaches two tracks or marks on the disk (col.3, lines 30-35).
21. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stein and Montagu as applied to claim 1 above, and further in view of Olexa ('586).
22. The obvious combination of Stein and Montagu teaches the claimed invention except for a retaining means and resiliently positioning the sample.
23. Olexa teaches the resiliently positioning a sample by the use of a spring clamp (or retaining means) (col.2, lines 55-61 of Olexa).
24. It would have been obvious to an ordinary artisan to incorporate the teachings of Olexa into the obvious combination mentioned since Olexa teaches the use of spring clamps are widely known and expected (col. 2, lines 60-61).
25. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stein and Montagu as applied to claim 1 above, and further in view of Polcyn et al ('940).
26. The obvious combination of Stein and Montagu teaches the claimed invention except for different wavelength laser source.
27. However, Polcyn et al teaches the use of a laser source having different wavelengths (col.2, lines 14-39).
28. It would have been obvious to incorporate the use of such a light source into the obvious combination since Polcyn teaches the advantage of generation of useful physical/ chemical data (col.2, lines 45-56).

29. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stein and Montagu as applied to claim 1 above, and further in view of Krantz.

30. The obvious combination teaches the claimed invention except for the axial and lateral ranges recited.

31. However, Krantz teaches the recited range (col.8, lines 25-33) (i.e. a beam spot of 1 μm and focus region of 100x100).

32. It would have been obvious to an ordinary skilled artisan to incorporate the teachings of Krantz since Krantz teaches a common, conventional laser beam.

Conclusion

33. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US Pat No 6,201,639 issued to Overbeck and US Pat No 5,216,247 issued to Wang et al.

34. Overbeck is incorporated by reference into Montagu and discloses the details of the limited rotatable scanning device (col.4, lines 45-52).

35. In addition, Wang et al ('247) teaches a rotatable optical scanning device (see fig.1) and relied upon to illustrate obviousness of optical scanning via a rotatable scanning device.

36. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Application/Control Number: 09/681,008
Art Unit: 2881

Page 6

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalimah Fernandez whose telephone number is 703-305-6310. The examiner can normally be reached on Mon-Fri between 7:00am-3:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Lee can be reached on 703-308-4116. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-872-9319 for After Final communications.

Application/Control Number: 09/681,008
Art Unit: 2881

Page 7

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

kf
July 16, 2002



JOHN R. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800